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PATENT AND TRADEMARK OFFICE

APPLICANT(S): Hirohisa A. Tanaka
APPLICATION NO.: 09/898,497
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TITLE: Method and Apparatus For Location-Sensitive, Subsidized Cell Phone Billing
EXAMINER: James S. McClellan
GROUP ART UNIT: 3627
ATTY. DKT. NO.: 20662-07121

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Dated: 10 March 2005

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REPLY BRIEF

This Brief is in reply to the Examiner's Brief mailed January 12, 2005.

Grouping of Claims

The Examiner indicates in his Brief that Applicant failed to include a statement as to which of the claims stand or fall together as required by 37 CFR

1.192(c)(7). However, since Applicant's Appeal Brief was filed subsequent to September 13, 2004, Applicant was required to comply with the rules for appeal briefs set forth in 37 CFR § 41.37. See Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule), 69 Fed. Reg. 49959 (August 12, 2004). Accordingly, no "Grouping of Claims" section was required or included in Applicant's Brief. 37 CFR § 41.37.

Argument

Owensby discloses offering a subsidy to subscribers who agree to receive an advertisement. If the user agrees to receive the ad, the user gets the subsidy. If the user does not agree to receive the ad, the user does not get the subsidy. (Owensby para. 32.) While Owensby may select the advertisement according to the location of the wireless mobile terminal, Owensby does not condition the subsidy on the location of the mobile terminal, as claimed. And, while the Examiner may be correct that technology existed at the time of filing of Owensby to determine a mobile telephone user's approximate location, nothing in Owensby suggests making the granting of a subsidy responsive to the location of the mobile user. If, *a priori*, a user in Owensby agrees to accept an advertisement, then the user's location plays no part at all in selecting the particular ad to display. In other words, the determination of whether to grant the subsidy in Owensby is based only on whether the user agrees to receive the advertisement—not based on where the user is located.

By contrast, the claimed invention ties the granting of a subsidy to the location of the mobile telecommunications unit (MU). If the MU is in a subsidized zone, a call is billed at a first rate. If the MU is not in a subsidized zone, the call is

billed at a second rate. Owensby simply does not anticipate the claimed invention. To further illustrate the point, consider in turn each of the limitations of claim 1 (annotated below for ease of reference as (a), (b), and (c)):

1. A method for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU), comprising the steps of:

- (a) determining whether a location of the MU is inside or outside a predetermined subsidized zone;
- (b) responsive to a determination that the location of the MU is inside the subsidized zone, adjusting the billing rate for the telecommunications connection to a first predetermined billing rate; and
- (c) responsive to a determination that the MU is outside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a second predetermined billing rate.

Element (a) recites determining whether an MU is inside or outside a predetermined subsidized zone. As disclosed in the application's written description, subsidized zones allow businesses to provide an incentive to mobile telecommunication users to visit the zones, for example to increase the likelihood that the users will then patronize the businesses located there. (Application, p. 13, lines 8-18). The concept of subsidized zones is entirely absent from Owensby, which is not surprising given that subsidies in Owensby are not location dependant. Accordingly, Owensby does not disclose element (a).

Element (b) recites adjusting the billing rate responsive to the MU being inside the subsidized zone. Again, since Owensby does not disclose subsidized zones, it follows that a billing rate cannot be adjusted if an MU is inside such a zone. The Examiner argues that by requiring the presence of the MU in a subsidized zone in order to adjust the billing rate Applicant is arguing limitations not found in the claims. (E.g., "The current scope of the claims does not include the term 'only' or any other similar modifying term") (Examiner's Brief, p. 4). To the contrary, the claim element explicitly recites that adjusting the billing rate is "responsive to a determination that the location of the MU is inside the subsidized zone" (emphasis added).¹

The Examiner's point is further undermined by the presence of element (c), which recites using a second billing rate if the MU is outside the predetermined subsidized zone. Once again, because Owensby does not disclose subsidized zones, he cannot anticipate adjusting a billing rate to a second rate responsive to the MU not being in such a zone.

Because Owensby does not disclose even a single element of claim 1, the Examiner's rejection should be reversed. Similarly, the rejections under 35 U.S.C. § 102(e) of claims 2, 4, 6-13, 15 17-24, 26, and 28-33 and the rejections under 35 U.S.C.

¹ The Examiner argues that the un-entered amendment made in Applicant's Amendment After Final adding "solely" after "responsive" is "a clear indication that Appellant realized that the current scope of the claim is anticipated by the system and method disclosed by Owensby" (Examiner's Brief, p. 4). That is simply untrue. The proposed addition of "solely" was in direct response to the Examiner's own suggestion in a telephone conference on May 25, 2004 (see, e.g., p. 7 of Applicant's un-entered Amendment C) and was made in an attempt to advance the application to allowance without the delay of additional proceedings. Applicant's position has always been that the "responsive to" language clearly differentiates the claimed invention from Owensby. See, e.g., Applicant's Amendment B, Sept. 29, 2003, p. 8. In any event, as the amendment was not entered, the only issues properly before the Board are those raised by the claims as they currently stand.

§ 103(a) of claims 3, 5, 14, 16, 25 and 27 should be reversed according to the same rationale.

The Examiner also mischaracterizes the example found in Applicant's brief in which two users, User A and User B each make a telephone call from the same location. (Applicant's Brief, p. 4.) According to the claimed invention, both Users would either both receive the subsidy or both not receive the subsidy (responsive to whether or not they are located in a subsidized zone). Following Owensby, User A can accept an advertisement and receive a subsidy, while User B standing in the same location refuses to view advertisements and therefore does not receive the subsidy. The Examiner concludes from this example that Applicant "is admitting that User A anticipates his claims" (Examiner's Br., pp. 4-5) (emphasis in original). That is not the case. User A under Owensby receives a subsidy in exchange for accepting advertisements, and not responsive to a determination that the MU (of User A) is inside a subsidized zone, as claimed. Far from admitting that Owensby anticipates the claimed invention, therefore, the example actually illustrates quite clearly how it does not anticipate.

Accordingly, the Examiner's rejections of claims 1-33 were erroneous, and Applicant respectfully requests that the Board reverse.

Respectfully submitted,
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